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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,977	08/20/2003	Hiroshi Yabe	XA-9308B	4975

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MILES & STOCKBRIDGE PC  
1751 PINNACLE DRIVE  
SUITE 500  
MCLEAN, VA 22102-3833

EXAMINER

BINDA, GREGORY JOHN

ART UNIT PAPER NUMBER

3679

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/643,977

Applicant(s)

YABE ET AL.

Examiner

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/573,941.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20030820</u> . | 6) <input type="checkbox"/> Other: ____  |

*Drawings*

1. The drawings are objected to because:
  - a. The "dimension" described on page 2, line 11 and the widths described on page 3, line 6, page 4, line 20 and page 5, line 20 are not identified in the drawings.
  - b. In Fig. 1, reference numerals 12 & 35 point to the same part, but in the description each identifies a unique part.
  - c. Fig. 1 shows splines 42 on the retainer plate 11, but in the description, the splines are described as being on the holder 35.
2. The drawings are objected to as failing to comply with 37 CFR 1.83(a) because they fail to show the limitations of claim 5, lines 5 & 6.
3. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

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by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

4. The disclosure is objected to because:
  - a. The cross reference to the related applications fails to identify the current status of those applications.
  - b. Page 2, line 11 includes the nonsensical phrase "a the dimension".
  - c. Page 2, line 11 states "the dimension in a radial direction becomes great." What is this "dimension"? The diameter of damper apparatus 51? If not, then what?
  - d. Page 3, line 6 includes "a width in a radial direction". Where (i.e. between what points) is this width measured?
  - e. On page 3, lines 20 & 21, the holder 35 is described as something in addition to the plates 11 & 12 and the ring 33, but in claim 3, the holder 35 is recited as an entity which comprises the plates 11 & 12 and the ring 33.
  - f. Page 4, lines 14 & 15 mentions "opponent" members. Are such members the same as opposing members?
  - g. Page 4, line 15, includes the term "inner splines 42", but the drawings fail to show the splines 42 inside of anything.
  - h. Page 4, lines 20 & 21 describes "widths of the retainer plates in a radial direction". Are these "widths" measure horizontally (i.e. axially) in Fig. 2? If so why are they described as being in the "radial direction"?

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5. The specification is objected to as failing to comply with 37 CFR 1.71 and 1.75(d)(1) because the detailed description fails to provide proper antecedent basis for the following claimed subject matter:

- a. All of the limitations of claims 4, 9 & 10
  - i. Claim 4. The thicknesses of the annular ring 33 and plate 13 are not described as being of equal thickness. In fact there must be some difference in thickness between the two in order for them to undergo relative movement without rubbing.
  - ii. Claim 4 & 10. A rivet is not described as being disposed through a spline of each of the retainer plates.
  - iii. Claim 9. Splines are not disclosed as being provided on retainer plates.
- b. The limitations in claim 7, lines 8 & 9. The opposite end surfaces of annular ring 33 and plate 13 are not described in the specification.

*Claim Objections*

6. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 8 merely repeats the limitations set forth in claim 7, line 5.

*Claim Rejections - 35 USC § 112*

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 4 & 7-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There does not appear to be a written description of the following limitations in the application as filed.

a. Claim 4, line 2: "the annular ring has a substantial equal thickness . . . to the thickness of the plate". As noted in item 5ai above, the thicknesses of the annular ring 33 and plate 13 are not disclosed as being of equal thickness. The drawings show that the thicknesses are not equal because they show the ring and plate as being capable of relative movement without rubbing.

b. Claim 7, line 8 & 9: "opposite end surfaces of said annular ring are substantially aligned with opposite end surfaces of said plate". As noted in item 5b above, the opposite end surfaces of annular ring 33 and plate 13 are not described in the specification. The drawings show that the end surfaces of ring and plate are not aligned because they show the ring and plate as being capable of relative movement without rubbing.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 4, 9 & 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

c. The term "substantial equal" in claim 4, line 2 is a relative term which renders the claim indefinite. The term "substantial equal" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. There is no disclosure of how to make the plate and ring substantially equal thicknesses. Therefore there are no means to determine to what extent the thickness of each member can be different (so as to allow relative movement without rubbing) and still be "equal" as recited in the claim.

d. Claim 4, lines 4+ recite "a spline of each of said retainer plates and said annular ring". It is not clear if this "spline" is included with or exclusive of the splines provided on the holder per claim 1, lines 5 & 6.

e. The term "substantially aligned" in claim 7, line 8 is a relative term which renders the claim indefinite. The term "substantially aligned" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. There is no disclosure of how to make the end surfaces of the plate and ring "substantially aligned". Therefore there are no means to determine to what extent the end surfaces of each member must be offset (so as to allow relative movement without rubbing) and still be "aligned" as recited in the claim.

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f. Claim 9 recites "said splines". It is not clear if these "splines" include all of the splines recited in claim 7, lines 6+ or just some portion thereof.

g. Claim 10, line 2 recites "a spline of each of said retainer plates and said annular ring". It is not clear if this "spline" is included with or exclusive of the splines provided on the holder per claim 7, lines 6+.

*Claim Rejections - 35 USC § 102*

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Lopez, WO 98/45616 (all citations taken from its U.S. equivalent, US 6,186,898 B1). Fig. 1 shows a damper apparatus comprising: a spring 11; a holder 1, 9, 21, 22 for holding spring 11; a plate 10 having a pawl (radial edge of window 12 (see Fig. 3)) elastically engaged by spring 11; splines (see col. 6, line 8) on the inner peripheral portion of the plate 10; and splines (on outer edge of ring 21) on the outer peripheral portion of the holder. The holder is constituted by pinching an annular ring 21 between two retaining plates 1, 9 (see also col. 7, lines 35 & 36 and col. 10, lines 48-50).

13. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ara et al, DE 198 41 456 (Ara) (all citations taken from its U.S. equivalent US 6,223,625 B1).



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- a. Claims 1-4 & 7-10. Figs. 1-3 show a damper apparatus comprising: a spring 30; a holder 27, 31 for holding spring 30; a plate 26 having a pawl (radial edge of window 28 (see Fig. 2)) elastically engaged by spring 30; splines 32 on the inner peripheral portion of the plate 26; and splines 35 on the outer peripheral portion of the holder. The holder includes an annular ring 31 disposed between two retaining plates 27. Fig. 1 shows that the thickness of ring 31 is substantially equal to the thickness of plate 26. Figs 1 & 2 show that a rivet 36 is disposed through a spline 35 of each of said retainer plates 27.
- b. Claims 5 & 6. Figs. 1-3 show a damper apparatus comprising: a spring 30; a holder 26 for holding spring 30; a plate 27 having a pawl (radial edge of window 29 (see Fig. 2)) elastically engaged by spring 30; splines 32 on the inner peripheral portion of holder 26; and splines 35 on the outer peripheral portion of the plate 27. The holder 26 includes an annular ring 26. Fig. 1 shows that annular ring 26 is disposed between two retaining plates 27.

14. Claims 1, 2 & 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Gassmann, US 5,653,639. Fig. 3 shows a damper apparatus comprising all the limitations of the claims.

### *Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,743,105 B2 shows a damper apparatus.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (703) 305-2869. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda  
Primary Examiner  
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